

Application/Control No.: 10/637,201  
Response mailed August 25, 2005  
Reply to Office Action of November 23, 2005

### **REMARKS/ARGUMENTS**

This paper is submitted in response to the Office Action mailed August 25, 2005. Claims 1-27 were examined in the current Office Action and stand rejected. The Examiner also objected to the drawings for failing to show the claimed subject matter in claim 15.

Applicants have cancelled claims 10 and 15. Applicants have amended claims 1, 6, 11, 13, 14, 16, 17, 22, and 23 and have added 2 new claims (claims 28 and 29). Applicants note that no new matter is being added by these amendments or new claims as the subject matter of the amendments and new claims is fully supported by the specification, drawings and claims as originally filed. In view of the foregoing amendments and the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and requests reconsideration of the application in this regard.

#### **Objection to Drawings**

The Examiner objected to the drawings under 37 CFR 1.83(a) because the claimed subject matter in claim 15 was asserted to have not been shown in the drawings. Applicants have cancelled claim 15, thus mooted this objection.

#### **Rejection of Claims Under 35 U.S.C. § 102(b)**

Claims 1, 3-6, 10-12, 16, and 22<sup>1</sup> stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,137,184 (Jackson et al.).

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<sup>1</sup> Although it is not included in the summary of claims rejected under 35 U.S.C. §102(b) as being anticipated by Jackson et al., claim 15 is also included in the subsequent discussion of the §102(b) rejections.

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It is well settled that "[a]nticipation under 35 U.S.C. § 102 means lack of novelty, and is a question of fact. To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M*, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001), *cert. denied*, 535 U.S. 970 (2002). Moreover, "[a] single reference must describe the claimed invention with sufficient precision and detail to establish that the subject matter existed in the prior art." *Verve LLC v. Crane Cams Inc.*, 65 U.S.P.Q.2d 1051, 1054 (Fed. Cir. 2002). Finally, in addition to the requirement that the anticipating reference describe the patented subject material with sufficient clarity and detail to establish that the subject matter existed in the prior patent, it must also establish "that such existence would be recognized by persons of ordinary skill in the field of the invention." *Crown Operations Int'l Ltd. v. Solutia Inc.*, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002).

Independent claim 1, as amended by Applicants herein, first recites that the claimed apparatus has an elongated tube, and more specifically, inter alia, an elongated tube that has a proximal end adapted to receive material from a container. However, as is readily apparent from the drawings and from a review of the Jackson et al. specification, Jackson et al., fails to disclose an elongated tube, and certainly not the recited elongated tube of independent claim 1 which has a proximal end adapted to receive material from a container. Instead of an elongated tube, Jackson et al. discloses a pair of cones. In the words of Jackson et al., "[t]he nozzle 40 has a double cone-shaped dispensing end portion with a rearwardly disposed tapered cone portion 42 and a forwardly disposed tapered cone portion 43 that terminates into an apex or tip portion." (Col. 4, ll. 23-27.)

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Independent claim 1 next recites that the claimed apparatus for adjusting the dispensation of material from a container has a flange, and as amended herein by Applicants, a flange attached at the proximal end of the tube. The Office Action equates the annular ring or base 41 disclosed in Jackson et al. with the recited flange. However, in Jackson et al., this ring 41 is not attached at the proximal end of the tube, to the extent Jackson et al. can even be considered to have a tube. Rather, as clearly shown in FIG. 2 of Jackson et al., this ring 41 is located distally away from the proximal end of the nozzle 40, which the Office Action equates with the recited tube.

Moreover, Applicants have also amended independent claim 1 to now recite (1) that the container has a shoulder; (2) that the flange is operably sandwiched between this container shoulder and the dispenser; and (3) that the flange keeps the apparatus in contact with this container shoulder during the dispensation of material from the container. The shoulder or discharge end of the container, cartridge, tube, or canister is referenced numerous times in the specification and identified in the original drawings with element identifier number 24.

However, as is readily apparent from merely comparing FIGS. 7-12 of the application with the disclosure of Jackson et al., Jackson et al. fails to disclose any discharge end shoulder or like wall which remains in place during the dispensation of material from the container. Rather, Jackson et al. discloses a removable zip top lid 18 with a pull tab 19 attached thereto which facilitates the removal of the lid 18 prior to the dispensing of any material. Once the zip top lid 18 is removed, the entire discharge or dispensing end of the cartridge 15 is open. In other words, once the zip top lid 18 is removed, there is no wall or shoulder between or within the discharge or dispensing

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end of the cylindrical body 16 which can be used, along with the dispenser, to operably sandwich the flange. Once the lid 18 is removed, Jackson et al. also obviously does not have any discharge end wall or shoulder to maintain contact with the apparatus during dispensation of the material from the container. Finally, once the zip top lid 18 is removed in Jackson et al., the cartridge again obviously has no discharge end wall or shoulder to allow the raised seal to seal against during the dispensation of material from the container.

Independent claim 1 concludes with the recitation of a raised seal having a perimeter, which, as amended herein, is attached medially to the flange. The Office Action equates the extension 46 of the nozzle 40 with the recited raised seal. However, in the plain words of Jackson et al., element 46 is merely an *extension* of the nozzle 40, i.e., it is really not a separate element at all, and certainly not one that can be said to properly anticipate the recited raised seal. Additionally, the extension 46 of Jackson et al. is clearly not medially attached to a flange.

Accordingly, for all of the foregoing reasons, Applicants respectfully request that the rejection of Independent claim 1, and dependent claims 3-6, 11, and 12 as being anticipated by Jackson et al. be withdrawn.

Turning more specifically to dependent claim 3, this claim further recites that at least a portion of the container is permitted to operably be positioned within the tube. Jackson et al. utterly fails to disclose this limitation. FIG. 2 of Jackson et al. indisputably shows that no portion of the cartridge 15 or its cylindrical body 16 is ever positioned within the nozzle 40. Accordingly, for this additional reason, Applicants respectfully request that the rejection of dependent claim 3 as being anticipated by

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Jackson et al. be withdrawn.

Turning next to dependent claim 16, the rejection of this claim under 35 U.S.C. §102(b) must, as a matter of law, be withdrawn. Claim 16 depends upon independent claim 13, and as such, incorporates all of the limitations of that claim. However, for at least the reason explained in the Office Action, Jackson et al. does not anticipate independent claim 13. Therefore, as a matter of law, Jackson et al. cannot anticipate any claims which depend from independent claim 13. Accordingly, Applicants respectfully request that the rejection of dependent claim 16 as being anticipated by Jackson et al. be withdrawn.

Independent claim 22 was the last claim the Office Action rejected under 35 U.S.C. §102(b). This claim first recites a flange projecting radially outwardly of an elongated tube and adjacent to the proximal end of the tube. Here again, the first issue is whether Jackson et al. even discloses an elongated tube. Jackson et al.'s pair of cones are simply not synonymous with the recited *elongated* tube. Additionally, as discussed with respect to independent claim 1, the annular ring or base 41 of Jackson et al., which the Office Action again here equates with the recited flange, is not attached at the proximal end of the nozzle 40, which the Office Action equates with the recited elongated tube. Rather, as clearly shown in FIG. 2 of Jackson et al., this ring 41 is located distally away from the end of the proximal end of the nozzle 40.

Moreover, Applicants have also amended independent claim 22 to now recite that the outer diameter of the proximal end of the elongated tube is less than the interior diameter of the annular sealing ring. This cannot be said of the structure disclosed in Jackson et al. For example, the extension 46 of Jackson et al., which the

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Office Action equates with the recited annular sealing ring, has an interior diameter which is clearly less than the exterior diameter of the proximal end of the nozzle 40. This point is further reenforced by the fact that interior diameter of the extension 46 and the interior diameter of the proximal end of the nozzle 40 are equal, thus requiring, by necessity, that the outer diameter of the proximal end of the nozzle 40 to be larger than the interior diameter of the extension 46.

Accordingly, for all of these reason, Applicants respectfully request that the rejection of independent claim 22 as being anticipated by Jackson et al. be withdrawn.

**Rejection of Claims Under 35 U.S.C. § 103(a)**

Claims 7, 8, and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson et al. in view of U.S. Patent No. 3,235,133 (Zimmerman et al.). Claims 13-15, 17-21, and 23-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson et al. in view of Zimmerman et al. and U.S. Patent No. 5,833,099 (Boaz et al.) Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson et al. in view of Boaz et al.

It is well settled that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992). "Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

As a threshold matter, Applicants note that independent claims 1, 13, 17, and 22

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have all been amended. In view of these amendments, neither Jackson et al. singularly, or in combination with any of the other cited §103(a) references, now contain all of the recited elements of these amended independent claims or the claims that depend therefrom. For example, as discussed above, there are numerous recitations in amended independent claim 1 that are missing from Jackson et al. Hence for these reasons alone, the rejection of claims 2 and 7-9 as being unpatentable over Jackson et al. in view of Zimmerman et al. should be withdrawn.

Additionally and more specifically, dependent claim 7 recites that the flange is comprised of a plurality of radially extending arms. Dependent claim 8 recites that the flange is scalloped and has a plurality of concave portions. Dependent claim 9 recites that the concave portions of dependent claim 9 do not inwardly extend inside the perimeter of the raised seal. According to the Office Action, it would have been obvious to modify Jackson et al. as taught by Zimmerman et al. to arrive at these claims. However, Zimmerman et al. does not actually teach the limitations cited as the bases for the modification of Jackson et al. Further, because Zimmerman et al. does not even teach these limitation, there is clearly no suggestion or incentive in Zimmerman et al. or Jackson et al. that would suggest the desirability or motivation to make such modifications. Indeed, as the opposite is actually true.

First, Zimmerman et al. does not teach the use of a nozzle having a flange. What the Office Action calls a nozzle, is defined in Zimmerman et al. as an elongated tube 28, and what the Office Action identifies as a flange, is a generally bell-shaped cap 34. Also, what the Office Action refers to as a plurality of radially extending arms is described in Zimmerman et al. as a knurled bottom flange 36. In sum, the elongated

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tube 28 in Zimmerman et al. is not flanged, nor is the bell-shaped cap 34 a flange.

Finally, the Office Action is silent as to how Zimmerman et al. teaches that scalloped flanges do not inwardly extend inside the perimeter of the raised seal. Zimmerman et al. is also silent on this point.

Moreover, even if Zimmerman et al. was considered, in a creative smorgasbord sort of way, to actually teach the limitations clearly absent in Jackson et al., there is still no reason stated, implied, or otherwise proffered why one skilled in the art would ever make such modification. Indeed, such modifications would be counterproductive to Jackson et al. and could even lead to its inoperability. For example, the annual ring or base 41 of Jackson et. has a rearwardly disposed annular tapered portion 45 which cooperates with the extension 46 to lock the nozzle 40 onto the cartridge 15. (Col. 4, ll. 50-56.) If one were to start chopping up the annual ring 41 into a plurality of radially extending arms or scalloping it, there would be less surface area to cooperate with the extension 46 to lock the nozzle 40 onto the cartridge 15. Given enough scalloping, the locking mechanism might even fail altogether. In any event, such modifications, in any degree, would clearly not be desirable.

Accordingly, for all these additional reasons, Applicants respectfully requests that the rejection of claims 7-9 as being unpatentable over Jackson et al. in view of Zimmerman et al. be withdrawn.

Turning next to independent claim 13 and dependent claim 14 which depends therefrom, Applicants have amended herein claim 13 to recite that the raised seal ring is attached medially to the scalloped flange. As discussed, the extension 46 of Jackson et al. is clearly not medially attached to a flange. As also discussed, Zimmerman et al.



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does not teach the use of a flanged tube, much less a flanged tube that is scalloped.

Applicants have also discussed the undesirability of modifying Jackson et al. in view of whatever is asserted to be taught in Zimmerman et al. Finally, as with claim 9, the cited references are silent as to the recitation of claim 14 which requires that the concave portions of the scalloped flanges do not extend inside the perimeter of the raised seal ring.

Additionally, to the extent that Boaz et al. discloses a flexible caulking nozzle, there is no teaching or suggestion in either Boaz et al. or Jackson et al. which would motivate one skilled in the art to apply this modification to Jackson et al. Indeed, the opposite is again true.

The nozzle 40 of Jackson et al. contains a plurality of circumferentially spaced longitudinally extending camming strips 44. These camming strips 44 are used to engage the inner periphery of the caulking gun ring in order to lock the nozzle 40 onto the ring 22 of the gun 10. (Col. 4, ll. 45-50.) By making the nozzle 40 flexible or bendable, the requisite rigidity to allow the camming strips 44 to function properly would be lost, or at least adversely affected. Accordingly, such a modification would not be desirable.

For all these reasons, Applicants respectfully requests that the rejection of claims 13 and 14 as being unpatentable over Jackson et al. in view of Zimmerman et al. and Boaz et al. be withdrawn.

Turning to independent claim 17 and dependent claims 18-21 which depend therefrom, Applicants first note that they have again amended herein claim 17 to now recite that the raised seal is attached medially to the flange. As discussed, no cited

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reference discloses such a limitation. Additionally, for the reasons discussed above, the cited references further do not disclose a flexible extender nozzle with a scalloped flange, or if they do in smorgasbord way, there is a clear bias against making such modifications. Finally, Applicants especially note that this claim recites a flexible *extender* nozzle. Here again, the cartridge 15 of Jackson et al. does not contain a nozzle which can be extended. Accordingly, for all these reasons, Applicants respectfully requests that the rejection of claims 17-21 as being unpatentable over Jackson et al. in view of Zimmerman et al. and Boaz et al. be withdrawn.

With regard to independent claim 27, Applicants have discussed all the reasons the cited references either fail to disclose all of the recited elements (e.g., an elongated flexible plastic tube, a scalloped flange at the proximal end of the tube, etc.) and/or if they do, why they fail to teach the desirability of such modifications, but rather are biased against the proposed modifications.

In addition to what has been discussed, Applicants further note that this claim recites that the elongated tube tapers *uniformly* inwardly from the proximal end to the distal end. A mere glance at FIG. 2 of Jackson et al. shows that such is not the case with the nozzle 40. Nor could the nozzle 40 in Jackson et al. reasonably be so modified because of its proximal width. If the nozzle 40 in Jackson et al. was to uniformly taper away from the cartridge 15 in such a way as to arguably form an elongated tube, it would be so voluminous so as to waste much of the material in the nozzle 40. Similarly, if the nozzle 40 was modified so as to have a rapid uniform taper, it would cease to have any elongated tube functionality and merely be a pyramidal discharge cap.

Additionally, claim 27 recites that the inner extremities of the concave portions of

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the scalloped flanges are disposed outwardly of the annular sealing ring. The Office Action fails to cite a reference for this limitation or even discuss it. Indeed, none of the cited references disclose this limitation.

Accordingly, for all these reasons, Applicants respectfully requests that the rejection of claim 27 as being unpatentable over Jackson et al. in view of Zimmerman et al. and Boaz et al. be withdrawn.

Turning to dependent claim 2, for the reasons stated in the discussion of independent claim 1 and the discussion of the undesirability of modifying Jackson et al. to include a flexible nozzle, Applicants respectfully requests that the rejection of claim 2 as being unpatentable over Jackson et al. in view of Boaz et al. be withdrawn.

Finally, with regard to dependent claims 23-26, for the reason discussed in regards to independent claim 22, and the other discussions herein regarding the scalloped flanges, the position of the inner extremities of the concave portions of the scalloped flanges, and the uniform tapering of the elongate tube, Applicants respectfully requests that the rejection of claims 23-26 as being unpatentable over Jackson et al. in view of Zimmerman et al. and Boaz et al. be withdrawn.

#### **New Claims**

Applicant has added claims 28 and 29 to more particularly claim the disclosed invention.

New dependent claims 28 depends directly from amended dependent claim 11 which itself depends from amended independent claim 1. New dependent claim 29 depends directly from amended independent claim 13. Therefore, to the extent claims

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1, 11, or 13 are allowable, one or both of these claims, as a matter of law, must also be allowable.

More specifically, in addition to all the reason discussed with respect to the allowability of independent claim 1, new claim 28 further recites that diameter of the proximal end of the elongated tube is less than the interior diameter of the raised seal. As previously discussed, the extension 46 of Jackson et al., which the Office Action equates with the recited raised seal, is not so configured.

With regard to new claim 29, in addition to all the reason discussed with respect to the allowability of independent claim 13, it also further recites that diameter of the proximal end of the elongated tube is less than the interior diameter of the raised seal. Here again, the extension 46 of Jackson et al., which the Office Action equates with the recited raised seal, is not so configured.

In sum, each of these claims is fully supported by the specification, drawings and claims as originally filed and for the reasons discussed herein, Applicants believe they are in a condition for immediate allowance.

### **Conclusion**

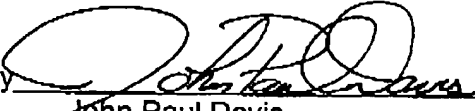
Applicants have made a bona fide effort to respond to each and every requirement set forth in the Office Action. In the event that any issue remains outstanding, the Examiner is invited to contact the undersigned attorney.

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Applicants are of the opinion that no additional fee is due as a result of this reply.  
If any charges or credits are necessary to complete this communication, the Commissioner  
is authorized to charge same or credit any overpayment to our Deposit  
Account No. 23-3000.

Respectfully submitted,

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